



**UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/863,047	05/23/97	ITU	35.C12088

005514 TM02/0706
FITZPATRICK CELLA HARPER & SCINTO
30 ROCKEFELLER PLAZA
NEW YORK NY 10112

EXAMINER
COLBERT, E

ART UNIT	PAPER NUMBER
2172	21

DATE MAILED: 07/06/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trad marks

Office Action Summary

Application No.

08/863,047

Applicant(s)

ITO ET AL.

Examiner

Ella Colbert

Art Unit

2172

-- Th MAILING DATE of this communication app ars on the cover sheet with th correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 April 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 3-5, and 8-61 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3-5, and 8-61 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____

Art Unit: 2172

DETAILED ACTION

Response to Amendment

1. Claims 1, 3-5, and 8-61 are presented for examination. Claims 1, 4, 5, and 9-14 have been amended in this communication filed 03/20/01, entered as amendment D, paper number 18.
2. Applicants' CPA filed 04/23/01 has been entered as paper number 20.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 3 - 5, and 8-61 are rejected under 35 U.S.C. 102(e) as being anticipated by Morita et al (US 5,832,470), hereafter Morita.

With respect to claim 1, a document retaining means for retaining a plurality of folders storing at least one document (**col. 2, lines 66-67 and col. 3, lines 1-10**), candidate folder selecting means for selecting a candidate folder for retaining a new document by comparing a feature of the new document with an average of features of the documents stored in a folder ... (**col. 3, lines 48-57, col. 6, lines 50-56 and col. 11, lines 1-17**), and providing advance notification of the candidate folder ... (**col. 12, lines 27-44 and col. 14, lines 50-67**). Morita did not explicitly teach, providing advance notification of a candidate folder, but it would have been obvious to one having ordinary

Art Unit: 2172

skill in the art at the time the invention was made to provide advance notification and to modify Morita's system to provide advance notification of a candidate folder because such a modification would enhance Morita's hierarchical document arrangement and classification of placing documents into folders.

With respect to claim 3, candidate folders suitable for saving the new document are selected and a list of selected candidate folders is displayed (**col. 16, lines 29-52**).

With respect to claim 4, judging a similarity degree between document information and sets of information of documents stored in a folder (**col. 13, lines 12-25**), calculating a similarity order of a plurality of folders in accordance with the similarity judged by the judging means (**col. 13, lines 26-35**) and providing notification of the similarity order of

the plurality of folders calculated by said similarity order calculating means (**col. 12, lines 42-67**). Morita did not explicitly teach, providing notification of a similarity order, but it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide notification of a similarity order and to modify Morita's system to provide notification of a similarity order because such a modification would enhance Morita's hierarchical structure and the classified result of the output.

With respect to claim 5, retaining a plurality of folders for storing a plurality of sets of documents (**col. 3, lines 20-32**), selecting a folder from the plurality of folders based on a number of sets of document information containing a keyword inputted as a search condition (**col. 25, lines 27-35 and lines 63-67 and col. 26, lines 1-9**), and providing an advance notification of the folder selected by the folder determining means (**Col. 29, lines 57-67 and col. 30, lines 1-3 and lines 60-67**). Morita did not explicitly

Art Unit: 2172

teach, providing advance notification of a candidate folder, but it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide advance notification and to modify Morita's system to provide advance notification of a candidate folder because such a modification would enhance Morita's hierarchical document arrangement and classification of placing documents into folders.

With respect to claim 8, the selecting means selects the folder through statistical estimation using the number of information sets of documents belonging to the folder and the number of documents matching the search condition (**col. 11, lines 53-57 and col. 24, lines 36-57**).

With respect to claim 9, This independent claim is rejected for the similar rationale given for claim 1.

With respect to claim 10, this independent claim is rejected for the similar rationale given for claim 4.

With respect to claim 11, this independent claim is rejected for the similar rationale given for claim 5.

With respect to claim 12, this independent claim is rejected for the similar rationale given for claims 1 and 9.

With respect to claim 13, this independent claim is rejected for the similar rationale given for claims 4 and 10.

With respect to claim 14, retaining a first plurality of folders storing a plurality of sets of document information (**col. 12, lines 27-34**), selecting a second plurality of folders from the first plurality of folders based on a number of sets of document

Art Unit: 2172

information ... (**col. 12, lines 35-42**), and providing notification of a particular folder selected in the selecting step (**Col. 29, lines 57-67 and col. 30, lines 1-3 and lines 60-67**). Morita did not explicitly teach, providing advance notification of a particular folder, but it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide advance notification and to modify Morita's system to provide advance notification of a particular folder because such a modification would enhance Morita's hierarchical document arrangement and classification of placing documents into folders.

With respect to claim 15, this dependent claim is rejected for the same rationale given for claim 3.

With respect to claim 16, this dependent claim is rejected for the same rationale given for claims 3 and 15.

With respect to claim 17, updating the feature of the folder in response to saving the new document in the candidate folder (**col. 14, lines 5-10**).

With respect to claim 18, the document includes vector data (**col. 11, lines 20-36**).

With respect to claim 19, the candidate folder has a high-level rank as determined by the result of the comparison (**col. 12, lines 45-64**).

With respect to claim 20, a notifying means displays a label which is set in advance to indicate the candidate folder (**col. 25, lines 19-35**).

With respect to claim 21, the document includes text data (**col. 25, lines 40-62**).

Art Unit: 2172

With respect to claim 22, means for causing the selected candidate folder to save the new document (**col. 26, lines 10-38**). Morita did not explicitly teach, saving the new document, but it is well known in the art by one having ordinary skill in the art to save a new document to a folder because a user can retrieve the saved document to the folder and retrieve the document to work on when needed.

With respect to claim 23, this dependent claim is rejected for the similar rationale given for claim 17.

With respect to claim 24, this dependent claim is rejected for the similar rationale given for claim 18.

With respect to claim 25, this dependent claim is rejected for the similar rationale given for claim 19.

With respect to claim 26, this dependent claim is rejected for the similar rationale given for claim 20.

With respect to claim 27, this dependent claim is rejected for the similar rationale given for claim 21.

With respect to claim 28, this dependent claim is rejected for the similar rationale given for claim 22.

With respect to claim 29, this dependent claim is rejected for the similar rationale given for claim 23.

With respect to claim 30, this dependent claim is rejected for the similar rationale given for claims 18 and 24.

With respect to claim 31, this dependent claim is rejected for the similar rationale given for claims 19 and 25.

With respect to claim 32, this dependent claim is rejected for the similar rationale given for claim 20.

With respect to claim 33, this dependent claim is rejected for the similar rationale given for claim 21.

With respect to claim 34, this dependent claim is rejected for the similar rationale given for claims 22 and 28.

With respect to claim 35, a notification only for a predetermined number of folders with a high rank of similarity order (**col. 12, lines 42-64**).

With respect to claim 36, the document is stored in a folder mentioned in the notification provided (**col. 12, lines 65-67 and col. 13, lines 13-19**).

With respect to claim 37, this dependent claim is rejected for the similar rationale given for claim 26.

With respect to claim 38, this dependent claim is rejected for the similar rationale given for claim 27.

With respect to claim 39, this dependent claim is rejected for the similar rationale given for claim 35.

With respect to claim 40, the document is stored in at least one folder mentioned in the notification in the notifying step (**col. 2, lines 66-67 and col. 3, lines 1-19**).

With respect to claim 41, this dependent claim is rejected for the similar rationale given for claims 26 and 37.

Art Unit: 2172

With respect to claim 42, this dependent claim is rejected for the similar rationale given for claim 33.

With respect to claim 43, this dependent claim is rejected for the similar rationale given for claims 35 and 39.

With respect to claim 44, this dependent claim is rejected for the similar rationale given for claim 40.

With respect to claim 45, this dependent claim is rejected for the similar rationale given for claim 41.

With respect to claim 46, this dependent claim is rejected for the similar rationale given for claim 33.

With respect to claim 47, notifying means displays a label set in advance to indicate the selected folder (**col. 25, lines 8-18 and lines 19-35**).

With respect to claim 48, the selected folder contains a predetermined number of folders highly ranked in number (**col. 16, lines 53-67 and col. 17, lines 1-4**).

With respect to claim 49, the selecting means selects folders which are highly ranked in including the keyword (**col. 20, lines 40-62**).

With respect to claim 50, the document information includes text data (**col. 25, lines 40-62**).

With respect to claim 51, a control means for causing the selected folder to store the document information (**col. 21, lines 19-30**).

With respect to claim 52, this dependent claim is rejected for the similar rationale given for claim 47.

Art Unit: 2172

With respect to claim 53, this dependent claim is rejected for the similar rationale given for claim 48.

With respect to claim 54, this dependent claim is rejected for the similar rationale given for claim 49.

With respect to claim 55, this dependent claim is rejected for the similar rationale given for claim 50.

With respect to claim 56, this dependent claim is rejected for the similar rationale given for claim 51.

With respect to claim 57, this dependent claim is rejected for the similar rationale given for claim 52.

With respect to claim 58, this dependent claim is rejected for the similar rationale given for claim 48.

With respect to claim 59, this dependent claim is rejected for the similar rationale given for claim 49.

With respect to claim 60, this dependent claim is rejected for the similar rationale given for claim 55.

With respect to claim 61, this dependent claim is rejected for the similar rationale given for claim 51.

Response to Arguments

5. Applicant's arguments filed 04/23/01 have been fully considered but they are not persuasive.

Art Unit: 2172

With respect to Applicant's argument: No suggestion is seen that a comparison is made between a new document and the documents in each of the plural existing folders as recited in claim 1 has been considered but is not persuasive because the Examiner does not find the claim as reciting "that the comparison made between a new document and the documents in each of the plural existing folders" nor does the Examiner interpret the claim as reciting this limitation.

With respect to Applicant's argument: Morita fails to teach or suggest that folders are used to retain a new document or that the result of processing (a candidate folder) is submitted to a user, as is done by the notifying means recited in claim 1 has been considered but is not persuasive because in response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which Applicant relies (i.e., folders are used to retain a new document or that the result of processing (a candidate folder) is submitted to a user, as is done by the notifying means) are not recited in the limitations of the rejected claim(s). As far as can be seen, the Morita system automatically assigns the documents it is processing to a folder based on its analysis, and notifies the user of the hierarchical classification that has been produced by the system. The user does not receive notification of a candidate folder – that is, a folder that the system proposes as a suitable folder for a given document to be assigned to, but which the user can presumably accept or reject. The user can presumably accept or reject a folder that the system proposes as a suitable folder for a given document to be assigned to is not found in the claims by the Examiner nor is it found in the Applicant's Specification. Although the claims are

Art Unit: 2172

interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

The Examiner is entitled to give claim limitations their broadest reasonable interpretation in light of the Specification (see below):

2111 Claim Interpretation; Broadest Reasonable Interpretation [R-1]

>CLAIMS MUST BE GIVEN THEIR BROADEST REASONABLE INTERPRETATION

During patent examination, the pending claims must be "given the broadest reasonable interpretation consistent with the specification." Applicant always has the opportunity to amend the claims during prosecution and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. In re Prater, 162 USPO 541,550-51 (CCA 1969) (Claim 9 was directed to a process of analyzing data generated by mass spectrographic analysis of a gas. The process comprised selecting the data to be analyzed by subjecting the data to a mathematical manipulation. The examiner made rejections under 35 U.S.C. 101 and 102. In the section 102 rejection, the examiner explained that the claim was anticipated by a mental process augmented by pencil and paper markings. The court agreed that the claim was not limited to using a machine to carry out the process since the claim did not explicitly set forth the machine. The court explained that "(reading a claim in light of the specification, to thereby interpret limitations explicitly recited in the claim, is a quite different thing from 'reading limitations of the specification into a claim,' to thereby narrow the scope of the claim by implicitly adding disclosed limitations which have no express basis in the claim. "The court found that applicant was advocating the latter, e.g., the impermissible importation of subject matter from the specification into the claim.).<

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Liddy et al (US 6,026,388) taught vectors, categorization, and ranking documents.

Howell et al (US 5,689,699) taught folders and document processing.

Art Unit: 2172

Tokuda et al (US 5,878,398) taught categories, judging the document according to the document type.

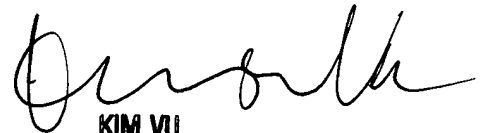
7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ella Colbert whose telephone number is 703-308-7064. The examiner can normally be reached on **Monday-Thursday from 6:30 am -5:00 pm**.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu can be reached on 703-305-4393. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-9051 for regular communications and 703-308-9051 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-96000.



E. Colbert
July 1, 2001



KIM VU
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100